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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/530,099	04/01/2005	Patrice Bujard	SE/2-22794/A/PCT	2615
324	7590	01/23/2008		
JoAnn Villamizar Ciba Corporation/Patent Department 540 White Plains Road P.O. Box 2005 Tarrytown, NY 10591			EXAMINER ABU ALI, SHUANGYI	
			ART UNIT 1793	PAPER NUMBER
			MAIL DATE 01/23/2008	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/530,099	Applicant(s) BUJARD ET AL.	
	Examiner Shuangyi Abu-Ali	Art Unit 1793	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 August 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9, 11, 12, 14-17 and 20-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9, 11, 12, 14-17 and 20-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

(1)

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 08/13/2007 has been entered.

(2)

Status of Claims

Claims 1-9, 11-12, 14-17 and 20-23 remain for examination wherein claims 1-3, 9, 14 are amended and claims 10, 13, and 18-19 are cancelled. Claims 22 and 23 are new.

(3)

Claim Objections

Claims 1, 3 and 9 are objected to because of the following informalities: please insert "layer" in line 6 (between the word of material and having) in claim 1.

For claim 3, please insert "layer" in line 3 (after index) in claim 3. Please adding "between the high and low "after difference in line 3.

Please insert "layer" in line 7(between the word of material and having) in claim 9.

Appropriate correction is required.

(4)

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 3 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 3 recites the limitation "the component" in line 2. There is insufficient antecedent basis for this limitation in the claim.

(5)

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1, 4, 6 and 9, 11-12, 15-17, 20-22 are rejected on the ground of nonstatutory double patenting over claims 6-7, 16-20, 23-30 and 36-37 of U. S. Patent No. 7, 256, 425 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: silicon suboxide containing pigment with dielectric material layers

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

Claims 9 and 20 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-18 of U.S. Patent No. 7,273,522. Although the conflicting claims are not identical, they are not patentably distinct from each other because both inventions are drawn to silicon suboxide based pigment with dielectric layers.

Claims 1-6 and 9-23 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-18 of copending Application No. 10/524457. Although the conflicting claims are not identical,

they are not patentably distinct from each other because both inventions are drawn to silicon suboxide based pigment with dielectric layers.

Claims 1-6 and 9-23 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1- 22 of copending Application No. 10/531483. Although the conflicting claims are not identical, they are not patentably distinct from each other because both inventions are drawn to silicon suboxide based pigment with dielectric layers.

Claims 1-6 and 9-23 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1- 20 of copending Application No. 10/533575. Although the conflicting claims are not identical, they are not patentably distinct from each other because both inventions are drawn to silicon suboxide based pigment with dielectric layers.

Claims 1-6 and 9-23 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1- 21 of copending Application No. 10/530098. Although the conflicting claims are not identical, they are not patentably distinct from each other because both inventions are drawn to silicon suboxide based pigment with dielectric layers

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 7 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-18 of copending Application No.

10/524457 in view of U. S. patent 6,238,471 to Vogt et al. Vogt et al. disclose a method of deposit metal oxide on the surface of silicate.

Claim 8 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-18 of copending Application No. 10/524457 in view of U. S. Patent 5,624,468 to Schmid et al. Schmid et al. disclose a method of method of depositing metal on the silicate flake.

This is a provisional obviousness-type double patenting rejection.

(6)

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 9 and 12 are rejected under 35 U.S.C. 102(e) as being anticipated by U. S. Patent No. 6,586,098 to Coulter et al.

Regarding claims 9 and 12, Coulter et al. disclose a pigment having a structure comprising a silicon dioxide layer and an Al layer and /or low/high dielectric layers (Figure 1A to Figure 5b; col. 7, lines 19-35, 40-55; col. 11, lines 15-25, lines 45-55; col. 12, lines 35-50 and col. 9, lines 10-25).

Coulter disclose that the pigment having a diameter of 1-100 micron and aspect ratio of larger than 2 (col. 9, lines 46-60).

Coulter et al. disclose that the pigment can be used in paint (col. 16, lines 58)

Claims 1, 3-6, 9-16, 20 and 22-23 are rejected under 35 U.S.C. 102(e) as being anticipated by US 2006/0165620 to Bujard et al.

The applied reference has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Regarding claims 1, 3-6, 9-16, 20 and 22-23 , Bujard et al. disclose a pigment , which can be used in cosmetic, having the structure of

[0170] In a preferred embodiment, the gloss pigment has the following layer structure: $\text{SiO}_x/\text{SiO}_z/\text{SiO}_x$, $\text{SiO}_z/\text{SiO}_x/\text{SiO}_z/\text{SiO}_x/\text{SiO}_2$, especially $\text{SiO}_2/\text{SiO}_x/\text{SiO}_z/\text{SiO}_x/\text{SiO}_2$, $\text{SiO}_x/\text{Al}/\text{SiO}_x$, $\text{SiO}_z/\text{SiO}_x/\text{Al}/\text{SiO}_x/\text{SiO}_2$, especially $\text{SiO}_2/\text{SiO}_x/\text{Al}/\text{SiO}_x/\text{SiO}_2$, $\text{TiO}_2/\text{SiO}_z/\text{SiO}_x/\text{SiO}_z/\text{SiO}_x/\text{SiO}_2/\text{TiO}_2$, especially $\text{TiO}_2/\text{SiO}_2/\text{SiO}_x/\text{SiO}_z/\text{SiO}_x/\text{SiO}_2/\text{TiO}_2$ or $\text{TiO}_2/\text{SiO}_z/\text{SiO}_x/\text{Al}/\text{SiO}_x/\text{SiO}_z/\text{TiO}_2$, especially $\text{TiO}_2/\text{SiO}_2/\text{SiO}_x/\text{Al}/\text{SiO}_x/\text{SiO}_2/\text{TiO}_2$, wherein x is from 0.03 to 0.95 and $0.95 < z \leq 2.0$, especially $1.40 < z \leq 2.0$.

[0179] $\text{SiO}_x/\text{SiO}_z/\text{SiO}_x$, $\text{SiO}_z/\text{SiO}_x/\text{SiO}_z/\text{SiO}_x/\text{SiO}_z$, especially $\text{SiO}_2/\text{SiO}_x/\text{SiO}_z/\text{SiO}_x/\text{SiO}_2$, $\text{TiO}_2/\text{SiO}_z/\text{SiO}_x/\text{SiO}_z/\text{SiO}_x/\text{SiO}_z/\text{TiO}_2$, especially $\text{TiO}_2/\text{SiO}_z/\text{SiO}_x/\text{SiO}_z/\text{SiO}_x/\text{SiO}_2/\text{TiO}_2$, wherein z is from 0.95 to 2.0, especially from 1.40 to 2.00 and x is from 0.03 to 0.95, especially 0.05 to 0.50.

[0180] The gloss pigments are generally particles having a length of from 2 μm to 5 μm , a width of from 2 μm to 2 μm , and a thickness of from 20 nm to 1.5 μm , and a ratio of length to thickness of at least 2:1, the particles having a core of SiO_2 having two substantially parallel faces, the distance between which is the shortest axis of the core, and an SiO_x layer applied to those parallel faces, and, optionally, further layers. The further layers may be applied to the parallel faces or to the entire surface.

[0181] The core is a platelet having an average diameter of from 1 to 50 μm and a thickness of from 20 to 500 nm.

[0182] The thickness of the SiO_x layer is generally from 5 to 200 nm, preferably from 5 to 100 nm.

[0183] The thickness of the SiO_z layer is generally from 1 to 200 nm, preferably from 2 to 100 nm.

[0184] The thickness of the TiO_2 layer is generally from 1 to 200 nm, preferably from 10 to 150 nm.

(7)

Response to Arguments

Applicant's arguments with respect to claim 1-23 have been considered but are moot in view of the new ground(s) of rejection.

(8)

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shuangyi Abu-Ali whose telephone number is 571-272-6453. The examiner can normally be reached on Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo can be reached on 571-272-1233. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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SUPERVISORY PATENT EXAMINER